

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California

Opposer,

VS.

University of South Carolina,

Applicant.

) Opposition No.: 125,615

) **74094681**
) Serial No.: ~~75/358,031~~

) Mark: "SC" (Stylized)

) **Reg# 1844953**
)
)
)

06-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIM FOR CANCELLATION

The Applicant, University of South Carolina ("Applicant"), through its undersigned attorneys, hereby submits its Answer to the Notice of Opposition filed by University of Southern California ("Opposer") against its application for registration of the mark "SC" (Stylized), Serial No.: 75/358,031, filed September 16, 1997, and published in the Official Gazette of May 18, 1999, as follows:

1. Unless expressly admitted herein, each allegation contained in the Notice of Opposition is denied.

2. As to paragraph 1 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to whether the Notice of Opposition was timely filed, and therefore, denies those allegations. The Applicant admits the remaining allegations of paragraph 1 of the Notice of Opposition.

3. As to paragraph 2 of the Notice of Opposition, Applicant admits only that Opposer has received a registration for "SC," U.S. Reg. No. 1,844,953 and that this

registration speaks for itself. Applicant lacks information sufficient to form a belief as to the truth of the remaining allegations of paragraph 2 of the Notice of Opposition, and therefore, denies those allegations.

4. Applicant denies the allegations of paragraph 3 of the Notice of Opposition and would further show that there is no likelihood of confusion between Opposer's and Applicant's marks.

5. Applicant denies the allegations of paragraph 4 of the Notice of Opposition and would further show that it is senior in priority having used the letters "SC" as a mark at least as early as 1898, if not earlier.

6. Applicant denies the allegations of paragraph 5 of the Notice of Opposition.

7. As to paragraph 6 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to the truth of the allegations regarding the extent of Opposer's advertisements and its expenditures, and therefore, denies those allegations. Applicant denies the remaining allegations of paragraph 6 of the Notice of Opposition.

8. Applicant denies the allegations of paragraph 7 and 8 of the Notice of Opposition.

9. Applicant denies the allegations of paragraph 9 of the Notice of Opposition and would further show that there is no possibility of any injury to Opposer through the granting of Applicant's registration.

FIRST AFFIRMATIVE DEFENSE

10. Opposer's Notice of Opposition fails to set forth facts sufficient to entitle the Opposer to the relief sought and should be dismissed pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. Applicant reserves the right to file a motion to dismiss.

SECOND AFFIRMATIVE DEFENSE

11. Opposer is not entitled to relief because there is no likelihood of confusion, mistake or deception because the Opposer's mark and the Applicant's mark are not confusingly similar, are used in connection with dissimilar goods and services, are sold through different channels of trade, and the relevant consuming public are discerning customers who can easily differentiate between their favorite team's products.

THIRD AFFIRMATIVE DEFENSE

12. Opposer is not entitled to relief under the doctrine of unclean hands based upon its fraud in obtaining U.S. Registration No. 1,844,953.

FOURTH AFFIRMATIVE DEFENSE

13. Opposer is not entitled to relief because Opposer's marks are generic or descriptive and incapable of serving as an indicator of source.

FIFTH AFFIRMATIVE DEFENSE

14. Opposer lacks standing to bring this Opposition Proceeding.

SIXTH AFFIRMATIVE DEFENSE

15. Opposer's Notice of Opposition should be dismissed because Opposer has previously released any claims against Applicant.

SEVENTH AFFIRMATIVE DEFENSE

16. Opposer should be estopped from opposing Applicant's registration of the "SC" (Stylized) mark.

EIGHTH AFFIRMATIVE DEFENSE

17. Opposer has waived any and all claims against Applicant over the use of the "SC" (Stylized) mark.

COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S MARK

18. Applicant hereby incorporates its defenses and allegations contained in paragraphs 1 through 17.

19. On September 5, 1990, Opposer filed an Intent to Use trademark application for the letters "SC." This application was given Serial No. 74/094,681. In this application, Opposer made a statement under oath to the U.S. Patent and Trademark Office that it had a bona fide intention to use the mark contained in the application for Serial No. 74/094,681 in connection with the goods contained in International Classes 6, 18, 24 and 25 of the application.

20. On January 20, 1994, Opposer amended its application to a use-based application. Thus, in this document, Opposer made a statement under oath to the U.S. Patent and Trademark Office that it had, in fact, first used the mark in commerce in International Class 6 since 1926 and in interstate commerce in International Class 6 since 1978; in International Class 8 since 1926 and in interstate commerce in International Class 8 since 1987; in International Class 24 since 1926 and in interstate commerce in International Class 24 since 1987; and in International Class 25 since 1926 and in interstate commerce in International Class 8 since 1987. This statement contained information material to the application and the

U.S. Patent and Trademark Office relied upon this statement in issuing U.S. Registration No. 1,844,953.

21. Upon information and belief, the Opposer's representations regarding the dates of first use were both false and misleading.

22. Opposer knew or should have known that the representations were false.

23. Opposer, intended for the U.S. Patent and Trademark Office and the public to rely on its representations and such reliance on the Opposer's representations was reasonable under the circumstances.

24. Applicant has since been damaged as a result of Opposer's fraudulent procurement of U.S. Registration No. 1,844,953.

WHEREFORE, having fully answered the Notice of Opposition and having filed a Counterclaim, the Applicant prays that the Opposition be dismissed, with prejudice, that its registration issue forthwith, that Opposer's registration for U.S. Registration No. 1,844,953 be cancelled, and for such other and further relief as the Trademark Trial and Appeal Board may deem just and proper.

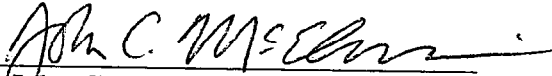
The required \$300.00 fee for the Counterclaim is submitted herewith.

Please recognize John C. McElwaine and Matthew D. Patterson, duly authorized to represent the Applicant in this matter, as the attorneys for the Applicant.

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By:



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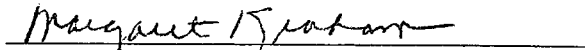
Attorneys for the University of South Carolina

Charleston, South Carolina

7/16, 2002

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513.


Margaret Kraham

Date: 07/16/2002

CERTIFICATE OF SERVICE

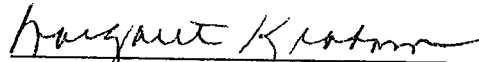
I, the undersigned Administrative Assistant of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings:

Answer to Notice of Opposition

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June 24, 2003

06-26-2003

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NO FEE

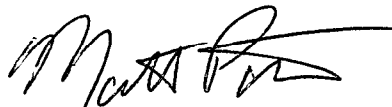
Gerard Rogers, Esq.
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: University of Southern California v. University of South Carolina
Our File No.: 13524/01501

Dear Mr. Rogers:

Pursuant to your request, enclosed please find another copy of the University of South Carolina's original answer and counterclaims in the above referenced matter. Additionally, please find a check for \$900 which represents the remainder of the outstanding filing fees owed by the University of South Carolina. Please contact me if you have any further questions.

Very truly yours,



Matthew D. Patterson

Enclosures

cc: Scott A. Edelman (w/ encl.)
Michael S. Adler (w/ encl.)

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